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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,361	10/25/2001	Sean M. O'Hara	10018528-1	7972

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EXAMINER	
BERGER, AUBREY H	

ART UNIT	PAPER NUMBER
2134	

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/046,361	O'HARA, SEAN M.	
	Examiner	Art Unit	
	Aubrey H. Berger	2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *October 25, 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☒ Claim(s) *1 and 7* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *October 25, 2001* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-17 have been examined.

Information Disclosure Statement

1. The information disclosure statement (IDS) was filed on May 14, 2002. The submission complies with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Drawings

2. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings incorrectly refer to the title of the invention as "BIOMETRIC WATER MIXING VALVE". The drawings must reflect the supplemental declaration submitted on September 12, 2002 which changed the title to "BIOMETRIC CHARACTERISTIC-ENABLED REMOTE CONTROL DEVICE." Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference element(s) mentioned in the description: the reference element called "step 420" (page 11, line 13) is not included in the drawings. "Step 420" is believed to correspond to the box labeled

"EXECUTE" in Figure 4 and has been treated as such for the remainder of this office action. Additionally, element "105" (page 7, line 3), element "108" (page 9, line 30), "the security device 102" (page 10, line 3) and "the base station 103" (page 10, line 4) are not included in the drawings.

Appropriate correction is required. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

1. The disclosure is objected to because of the following informalities: the word "device" is consecutively repeated. (Page 2, line 22). Additionally, the specification frequently recites "finger print" or "finger-print" and should be replaced with "fingerprint" for consistency.

Appropriate correction is required.

2. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the

embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

3. The use of the trade name "Bluetooth" has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trade name is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: In claim 16, the step of "optically scanning a finger print" is not described in the original disclosure.

Claim Objections

5. Claims 1 and 7 are objected to because of the following informalities: "from scanner" is recited in each claim, it should read "from the scanner" or "from said scanner".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 5 and 11-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. The term "Bluetooth", stated in claims 5 and 11, is a relative term which renders the claim indefinite. The term "Bluetooth" is a trade name and is not defined by the claim. The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. In fact, the value of a trade name would be lost to the extent that it became descriptive of a product, rather than used as an identification of a source or origin of a product. Thus, the use of a trademark or trade name in a claim to identify or describe a material or product would not only render a claim indefinite, but would also constitute an improper use of the trademark or trade name. See MPEP § 2173.05(u).

9. Claims 11-12 recite the limitation "said transmitter" in line 1 of each claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-3, 13 and 16-17 rejected under 35 U.S.C. 102(b) as being anticipated by Hsu et al (U.S. Patent 6,038,666).

Regarding claims 1-2 and 16-17, Hsu et al discloses an input device/handheld device (Fig. 1, #14 & Fig. 3, #38), that receives an input command from a user, a biometric scanner/a capacitive or optical sensor (Fig. 2, #16), adapted to obtain a first biometric characteristic/fingerprint of a user of said device, a memory/reference image storage (Fig. 3, # 32 & Column 2, lines 39-50), storing representations of a biometric characteristic/fingerprint of at least one individual, a processor/RISC processor (Fig. 3, #26), operatively coupled to: said biometric scanner/sensor, said memory, and said input device/handheld device, said processor/RISC processor, reading signals from said input device/handheld device, and reading signals from scanner/sensor, and comparing/correlator (Fig. 3, #28), biometric characteristics/fingerprint, as measured by said scanner/sensor, to representations of biometric characteristics/fingerprint, stored in memory/reference image storage, and a transmitter (Column 2, lines 50-56) coupled to said processor/RISC processor, and which transmits predetermined signals therefrom upon the identification/correlator (Fig. 3, #30), of a scanned biometric characteristic/fingerprint, to a stored representation of a biometric characteristic/fingerprint.

Regarding claim 3, Hsu et al discloses an optical retina scanner (Column 4, line 65-line 2, Column 5).

Regarding claim 13, Hsu et al discloses method of obtaining a first biometric characteristic/fingerprint of an individual at said remote control device/handheld device, generating a numeric representation/cyclic redundancy code (CRC) generator (Fig.3, #30), of said first biometric characteristic/fingerprint within said remote control device/handheld device, comparing said first biometric characteristic/fingerprint to the representation of a second biometric characteristic/fingerprint within said remote control device/handheld device to determine/correlator within said remote control device/handheld device if said first characteristic/fingerprint is substantially the same as said second characteristic/fingerprint, and if said first and second characteristics are substantially the same/correlator, transmitting a message to said slave appliance from said remote control device (Fig. 1A & 1B).

12. Claims 1, 4-7, 9-12, as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Wang et al (U.S. Publication 2003/0048904 A1).

Regarding claims 1, 4-7, 9-12, Wang et al discloses an input device (Fig. 1, #4) that receives an input command from a user, a biometric scanner/biometric capture device (Fig. 1, #2), adapted to obtain a first biometric characteristic/voice print or retina scan (paragraph 0002) of a user of said device, a memory/digitized data storage (Fig. 1, #3), storing representations of a biometric characteristic/voice print or retina scan, of at least one individual, a

processor/CPU (Fig. 1, #1), operatively coupled to: said biometric scanner/biometric capture device, said memory/digitized data storage, and said input device, said processor/CPU reading signals from said input device and reading signals from scanner/biometric capture device, and comparing biometric characteristics/voice print or retina scan, as measured by said scanner/biometric capture device, to representations of biometric characteristics/voice print or retina scan, stored in memory/digitized data storage, a transmitter/output device, Bluetooth device, RF Transmitter, or IR Transmitter (Fig. 1, #5 & paragraph 0021) coupled to said processor/CPU and which transmits predetermined signals therefrom upon the identification/collation and comparison (Fig. 2, #8), of a scanned biometric characteristic/voice print or retina scan, to a stored representation of a biometric characteristic/voice print or retina scan, and a tuner/RF Receiver (paragraph 0020), operatively coupled to and receiving signals from said processor/CPU, said signals from said processor/CPU enabling or inhibiting functionality of said tuner/RF Receiver.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wang et al as applied to claim 7 above, and further in view of Hsu et al.

Wang et al lacks a capacitive fingerprint scanner as the biometric scanner in the device of claim 7. Wang et al claims a fingerprint scanner but fails to specifically specify a capacitive finger print scanner. However, Hsu et al teaches it is known in the biometric art to use fingerprint scanners to capture biometric characteristics and more specifically how to utilize the methods of a capacitive fingerprint scanner (Fig. 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Wang et al using the more specific type of fingerprint scanner disclosed by Hsu et al. One of ordinary skill in the art would be motivated to perform such a modification because capacitive fingerprint scanners capture biometric characteristics as taught by Hsu et al (Fig. 2).

15. Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hsu et al as applied to claim 13 above, and further in view of Wang et al.

Hsu et al lacks infrared or radio frequency (RF) signals as the step of transmitting in the method of claim 13. However, Wang et al teaches that it is known in the transmission art to use an infrared or a RF transmitter to communicate signals containing biometric characteristics (paragraph 0021). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Hsu et al to use an infrared or RF transmitter to communicate signals containing biometric characteristics.

One of ordinary skill in the art would have been motivated to perform such a modification because infrared or RF signals are capable of transmitting biometric characteristics as taught by Wang et all (paragraph 0021).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aubrey H. Berger whose telephone number is 571-272-8155. The examiner can normally be reached on Monday - Friday, 7:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Morse can be reached on 571-272-3838. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AHB

May 16, 2005

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